

REMARKS

I. Summary of the Examiner's Action

A. Claim Rejections

As set forth at paragraph 2 of the August 26 Office Action, claims 18 – 28 and 30 – 32 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

As set forth at paragraph 6 of the August 26 Office Action, claims 1, 2, 11 – 15, 18 – 22 and 25 – 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,026,391 to Osborn (hereinafter “the Osborn patent”).

As set forth at paragraph 15 of the August 26 Office Action, claims 1, 2, 6 – 8, 11, 13, 18 – 20, 25, 26 and 29 – 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,847,938 to Moore (hereinafter “the Moore patent”).

As set forth at paragraph 26 of the August 26 Office Action, claims 3, 4, 9, 10, 16, 17, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Moore patent.

As set forth at paragraph 30 of the August 26 Office Action, claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Moore patent as applied to claim 1, and further in view of United States Patent Application No. US 2002/0059258 to Kirkpatrick

(hereinafter “the Kirkpatrick application”).

These rejections are respectfully disagreed with, and are traversed below.

II. Applicants’ Response

A. Applicants’ Response to Examiner’s General Response

Regarding the Examiner’s comment in paragraph 7 of the August 26, 2005 Office Action that “claims cannot be allowed on the general meaning of the terms”, Applicant’s Representative is not quite sure what the Examiner means by this statement, or where he derives legal authority for this statement, or why it was even necessary to make this statement in view of remarks presented by Applicants in their May 23, 2005 Response. Applicant’s Representative was seeking to help the Examiner understand Applicants’ invention and presented an explanation, starting with the specification, which does not contradict the plain meaning of the claims.

Examiner’s comments in paragraph 7 would give one the impression that only arguments based in generalities and finding no foundation in claim terminology were presented in the May 23 Response. Such an impression would be mistaken. A review of the May 23 Response regarding the Osborn patent indicates that Applicants started with an explanation of their invention based on the specification (See page 16, line 8 – page 18, line 3) and finished with arguments based on specific claim elements (See page 18, line 4 – page

19, line 10). Given that it is a commonplace that claims are to be construed in light of the specification, Applicants do not understand why the Examiner finds a problem with the method of argumentation relied on by Applicants.

Regarding the Examiner's exegesis about a potential purported need to issue a 35 U.S.C. § 112 rejection, does the Examiner suggest that this is necessary whenever Applicants seek to explain their claims by referring to the specification? The MPEP is quite clear about the level of clarity necessary and the relative roles of the parties at MPEP 2173.02 (reproduced here):

“Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.”

B. Rejection of Claims 18 – 28 and 30 - 32 under 35 U.S.C. § 101

Applicants have amended claims 18, 20 and 30 thereby overcoming the rejection of these claims, and any claims dependent from these claims on the basis of 35 U.S.C. § 101.

Regarding the rejection of claim 31, Applicants respectfully request that the Examiner read the claim carefully. Claim 31 (both as amended and prior to the current amendment)

recites “a communication device for operation with the performance prediction service, comprising a communication interface adapted for at least one of submitting . . .” Applicants respectfully request in view of the recitation of structure apparent in this portion of the claim that the Examiner withdraw the rejection of this claim.

C. Rejection of Claims 1, 2, 11 – 15, 18 – 22 and 25 - 33 under 35 U.S.C. § 102(b) over the Osborn patent

Claim 1, as amended, is reproduced here as a convenience to the Examiner:

1. A performance prediction system, comprising:
 - at least one memory to store a plurality of computer program components, the computer program components further comprising:
 - a query component for receiving queries submitted by users for data relevant to the probability that a transaction with a specific entity will be successful;
 - a data gathering component for storing relevant data about submitted queries; and
 - a meta-query component responsive to a meta-query for returning information regarding previously submitted queries; and
 - at least one data processor to execute the computer program components.

Applicants have carefully considered Examiner’s rejection of the claims over the Osborn patent, and now present further arguments to help the Examiner understand the difference between Applicants’ invention as claimed and the subject matter of Osborn.

Claim 1 recites “a query component for receiving queries submitted by users for data relevant to the probability that a transaction with a specific entity will be successful.” The Osborn patent says *nothing* about what the queries submitted to its database seek.

Instead, the Osborn patent concerns methods and apparatus that provide time estimates for the amount of time required to respond to a database query:

“The present invention provides methods and apparatus for providing an estimate of the elapsed time required for a computer system to respond to database queries.

In a preferred embodiment, a query performance prediction (‘QPP’) module is incorporated as part of an application residing on respective user stations connected to the computer system. The QPP module correlates estimated system cost information provided for each new query from the computer system DBMS with statistics compiled from previous queries in order to estimate the system response time to the present query.”

Osborn patent, Column 1, line 65 – column 2, line 8. As is apparent, Osborn is not concerned with the subject matter actually sought by database queries; instead, Osborn is concerned with providing an estimate of the time necessary to respond to database queries. In the Osborn method, this time estimate information is provided as a convenience to the entity submitting the database query to help the entity determine whether the database query can be performed by the time that the entity requires a response. If not, the entity can cancel the database query, since the information sought by the database query will not be received

“in time”. The information sought by the database query submitted by a user is *not* the time estimate.

In contrast to the method of the Osborn patent which is not concerned with the subject matter actually sought by database queries, Applicants’ invention *is* concerned with the subject matter sought by database queries. In fact, in Applicants’ invention, the queries seek a particular category of data – so-called “performance prediction data” or “data relevant to the probability that a transaction with an entity will be successful”:

“‘Performance prediction data’ generally refers to data relevant to the operation of businesses and other organizations that is typically maintained in a database and made available to users through operation of one or more queries. Performance prediction data is so named as it is typically useful as an aid in predicting the reliability, performance, or some such aspect of a business or other organization. For the purposes of this invention ‘enhanced performance prediction data’ generally refers to information that includes at least one component part that is derived from information descriptive of received queries for performance prediction data. Enhanced performance prediction data is so named as it is typically useful for providing insight not available in the performance prediction data, or for serving as an enhancement to the performance prediction data. Both performance prediction data and enhanced performance prediction data are generated and returned to a user in response to queries, which are referred to herein, for convenience only, as one of a ‘performance query’ and a ‘meta-query.’”

In general terms, a performance prediction query is directed to obtaining the performance prediction data, while a meta-query is directed to obtaining the enhanced performance prediction data. The performance

prediction data is generated by querying a data source, such as a database of product information. The enhanced performance prediction information is derived from a stored historical record of previously received queries.”

Application, page 5, lines 1 – 21 (emphasis added). As is apparent from Applicants’ description, the “performance prediction data” is *not* generated in an ancillary process unrelated to the subject matter sought by database queries as in the case of Osborn’s time estimation method. Rather, the performance prediction data generated in Applicants’ invention is provided in direct response to database queries seeking this information.

Applicants give an example of a context in which their invention is practiced:

“Another example of performance prediction data 133 and query-relevant data 132 involves the non-limiting context of a rating system. For example, in some on-line systems buyers and sellers can purchase goods or services or can exchange goods or services, and can also rate various aspects of transactions. For example a potential buyer sends a performance query 121 to ascertain performance prediction information related to a potential seller. The returned information may include information related to the seller’s reputation in previous transactions, customer satisfaction survey information, and other such data. The buyer or the seller using the system 101 may issue a meta-query 122 to ascertain enhanced performance prediction information. The enhanced information includes, for example, information descriptive of queries 120 received from previous potential buyers concerning the seller, queries received that included only the sellers in the results, queries received that excluded the seller from the results, the number of queries received about the seller, copies of received queries, copies

of results returned in response to received queries, how many queries were received during some prescribed period of time; patterns of queries received (e.g., queries received from specific locations, or from specific users), and correlations between queries.”

Application, Page 9, lines 6 – 23.

When Applicants’ claims are construed in light of the specification and, in particular, with respect to the definitions provided by the Applicants, it is clear that the Osborn patent has little or nothing to do with the subject matter of Applicants’ claims.

The Osborn patent merely provides a bare time estimate to a user performing a database query so that the user can assess whether the amount of time to perform the search accords with the user’s needs. Nowhere does the Osborn patent either describe or suggest “a query component for receiving queries submitted by users for data relevant to the probability that a transaction with a specific entity will be successful” as in the case of claim 1.

In addition, the Examiner is apparently applying the apparatus of Osborn to encompass both the “performance prediction system” and “entity” of claim 1. It is clear from the portions of the Application reproduced in this paper that the “entity” in claim 1 with which business may be transacted is a person, business or other organizational group and not the “performance prediction system” itself!

Further, Applicants note that claim 1 additionally recites “a meta-query component responsive to a meta-query for returning information regarding previously submitted queries.” It is not seen how the Osborn method can meet this element of claim 1, since this element seeks information derived from past database queries. The operations performed by Osborn having to do with estimating the time necessary to respond to a database query based on actual times achieved in responding to past database queries do not describe or suggest a “meta-query component” since a “meta-query component” is concerned with information derived at least in part, from past database queries. The time estimation method of Osborn is not concerned with the subject matter actually sought by queries submitted to databases, so it cannot disclose a “meta-query component” as in the case of Applicants’ invention. In other words, it is not seen how a reference which in no way describes or suggests aspects or details of database queries can disclose a particular type of database query – “a meta-query”.

For the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 1. Applicants respectfully submit that independent claims 13, 18, 20 and 29 – 31 are patentable for reasons similar to those concerning claim 1 and for other reasons attributable to their unique features. As a result, Applicants respectfully request that the rejection of independent claims 13, 18, 20 and 29 – 31 on the basis of the Osborn patent be withdrawn as well. Further, Applicants respectfully request that the rejection of dependent claims 2, 11 – 12, 14 – 15, 19, 21 – 22 and 25 – 28 over Osborn be

withdrawn for reasons similar to those recited with respect to claim 1 and for other reasons attributable to their unique features.

D. Rejection of Claims 1, 2, 6-8, 11, 13, 18 – 20, 25, 26 and 29 - 31 under 35 U.S.C. § 102(e) over the Moore patent

Applicants have amended claim 1 so that it recites “a query component for receiving queries submitted by users for data relevant to the probability that a transaction with a specific entity will be successful . . .”. The other claims have been similarly amended. The amendment clarifies that the queries received by the query component seek information about a particular (“specific”) entity. The Moore method does not operate in this manner. Rather, it receives a submission from a user specifying an item available for barter. The submission received from a user in Moore does *not* identify a specific entity, and does *not* seek information concerning the specific entity.

This is apparent from the description provided by Moore. The Moore patent concerns methods and apparatus for matching parties to a barter transaction:

“The present invention is generally a system that coordinates exchanges of items between individuals without the requirement that money actually change hands. Through an internet site, an individual seeking to take part in a trade can be automatically matched to another individual with a complementary position. For example, Party 1 having Item A and desiring to swap Item A for Item B could be matched by the system to Party 2, who is registered within the system as owning Item B and desiring Item A. The

system can also accommodate multi-party exchanges where three or more parties are involved in the exchange.”

Moore patent, Column 4, lines 11 – 21. It is not seen where such a system that merely provides matches in barter transactions has anything to do with Applicants’ invention as claimed. In contrast to the Moore patent, Applicants’ invention comprises methods and apparatus which, for example, receive “queries submitted by users for data relevant to the probability that a transaction with a specific entity will be successful” (claim1). The Moore patent neither describes nor suggests embodiments where a party to a potential barter transaction seeks information concerning another specific party to the barter transaction.

The fact that the methods and apparatus of the Moore patent do not transact in, for example, business reputation information as in the case of Applicants’ invention is made even more clear when information that reflects on the reputation of a user of Moore’s system is discussed. Instead of recording information concerning, for example, the lack of trustworthiness of a user so that other users can access this information when deciding whether to transact business with the untrustworthy user, the Moore patent provides a *failsafe* system so that a transaction will be completed regardless of the trustworthiness of users:

“In one embodiment of the present invention, the system may be a feature of an online club (e.g., an online CD exchange club). The club may require that users pay a fee to become members, where the fee is used to guarantee exchanges. For example, if a member entered into an exchange without actually possessing the item he committed to providing, his fee could

be used by the club to purchase a new version of the same item so that the other party to the exchange is protected.”

Moore patent, Column 4, line 61 – column 5, line 2. Notably absent from this or any other portion of the Moore patent is the appreciation that reputation information concerning the trustworthiness of a user may be found useful by other users of the system. For example, a user might decide not to enter into a transaction with another user merely to avoid the headache associated with submitting a claim for a new item when the other party to the transaction did not possess the item required for the transaction. Moore does not end with this particular example and continues providing other examples of untrustworthiness and possible trustworthiness:

“The club may also add a nominal surcharge to each transaction to maintain the system and promote the club for its own growth. In other embodiments, the system of the present invention maintains an accounting of member fees to ensure that members who engage in exchanges are active, that is, paid in full to date. The system of the present invention may also be part of a club that functions on a point system, where members can be credited or assessed points that may be exchanged at some later time for items in the club’s inventory or items possessed by other club members.”

Moore patent, Column 5, lines 2 – 12. Again, there is no description or suggestion that information which may be useful in helping users to decide with whom to transact business is provided by the methods and apparatus of the Moore patent.

For these reasons, Applicants respectfully submit that the Moore patent neither describes nor suggests the subject matter of claim 1. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 1 on this basis. In addition, Applicants respectfully submit that independent claims 13, 18, 20 and 29 – 31 are patentable for reasons similar to claim 1 and for other reasons attributable to their unique subject matter. For these reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 13, 18, 20, and 29 – 31. Likewise, Applicants respectfully request that the Examiner withdraw the rejection of claims 2, 6 – 8, 11, 18 – 19 and 25 – 26 for reasons similar to those submitted above with respect to claim 1 and for reasons attributable to their unique subject matter.

E. Rejection of Claims 3, 4, 9, 10, 16, 17, 23 and 24 under U.S.C. § 103(a) over the Moore patent

As set forth above, the Moore patent merely provides matches for barter transactions. Nowhere does the Moore patent either describe or suggest, for example, “a query component for receiving queries submitted by users for data relevant to the probability that a transaction with a specific entity will be successful” as recited in claim 1. As a result, since the Moore patent neither describes nor suggests the type of query transactions claimed by Applicants, neither can it describe or suggest the meta-query transactions recited in claims 3, 4, 9, 10, 16, 17, 23 and 24. For these reasons, Applicants respectfully request that the Examiner withdraw the rejection of these claims.

F. Rejection of Claim 5 under 35 U.S.C. § 103(a) over the Moore patent and Kirkpatrick application

Applicants respectfully submit that claim 5 is patentable as depending from a base claim that is allowable over the Moore for the foregoing reasons recited with respect to independent claim 1. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 5.

III. Conclusion

The Applicants submit that in light of the foregoing amendments and remarks the application is now in condition for allowance. Applicants therefore respectfully request that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

November 28, 2005 David M. O'Neill (35,304)

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